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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,049	06/08/2001	Nino R. Vaghi	T3379-907561	9037
34610	7590	05/02/2006	EXAMINER	
FLESHNER & KIM, LLP P.O. BOX 221200 CHANTILLY, VA 20153			ELAHEE, MD S	
			ART UNIT	PAPER NUMBER
			2614	

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/876,049

Applicant(s)

VAGHI ET AL.

Examiner

Md S. Elahee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 107, 108, 129 and 131-155 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 107, 108, 129 and 131-155 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This action is responsive to an amendment filed on 01/05/2006. Claims 107, 108, 129 and 131-155 are pending. Claims 1-106, 109-128, 130 have been cancelled. Claims 135-155 have been added.

Claim Objections

2. Claims 147 and 152 are objected to because of the following informalities: regarding claims 147 and 152, the citation 'receiving calls **from**' appears to be 'receiving calls **to**'. Appropriate correction is required.

Response to Arguments

3. The arguments filed in the 01/05/2006 Remarks have been fully considered but they are not persuasive because of the following:

Regarding claim 129, the applicant argues in page 11 that Norman does not teach changeable phone number is read by the reader from the removable storage medium. Examiner disagrees with this argument. Norman teaches that new MIN number [i.e., changeable phone number] is entered in the PCMCIA card [i.e., removable storage medium] (col.6, lines 13-14, col.12, lines 55-60, col.13, lines 19-23). When user inserts the PCMCIA card in cellular

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telephone, the device automatically reads dummy MIN number from the card. Therefore, it is clear that Norman teaches changeable phone number is read by the reader from the removable storage medium.

The applicant further argues in page 11 that Norman does not teach the changeable phone number does not correspond to the mobile user's telephone number and is not stored on memory card. Examiner again disagrees with this argument. Norman teaches that dummy MIN number [i.e., mobile user's telephone number] is pre-assigned to the user mobile device and new MIN number [i.e., changeable phone number] is given to the mobile device (col.6, lines 13-14, col.12, lines 12-32). Therefore, it is clear that the changeable phone number corresponds to the mobile user's telephone number. Norman further teaches that new MIN number [i.e., changeable phone number] is stored in the PCMCIA card [i.e., removable storage medium] (col.12, lines 55-60, col.13, lines 19-23). Therefore, the rejection of the claim in view of Norman will remain.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 107, 108, 129, 131, 132, 134-136, 139, 141 and 144 are rejected under 35 U.S.C. 102(b) as being anticipated by Norman et al. (U.S. Patent No. 5,485,505).

Regarding claim 107, Norman teaches inherently a keypad (fig.3; col.11, lines 14-16).

a cellular telephone 10 [i.e., wireless communication unit] (fig.3).

a memory unit for storing activation information input through the keypad (col.9, line 56-col.10, line 2).

a controller [i.e., processor] (fig.1, item 50) for automatically setting the cellular telephone to receive one or more calls from a wireless service provider, the processor automatically setting the new cellular MIN number [the claimed changeable phone number] to receive the calls based on that the dummy MIN number [the claimed user's mobile telephone number] was being called for performing such setting (fig.2,5; col.5, lines 1-16, 66, 67, col.6, lines 1-19, col.9, line 56-col.10, line 9, col.11, lines 8-21, col.12, lines 12-32). (Note: Norman teaches that dummy MIN number [i.e., mobile user's telephone number] is pre-assigned to the user's mobile device and new MIN number [i.e., changeable phone number] is given to the user's mobile device (col.6, lines 13-14, col.12, lines 12-32). Thus it is clear, Norman teaches that the changeable phone number corresponds to the mobile user's telephone number.)

Claim 108 is rejected for the same reasons as discussed above with respect to claim 107. Furthermore, Norman teaches an inherent hard-wired telephone including a keypad and a transceiver (fig.2; col.11, lines 22-36, col.12, lines 1-11).

a cellular telephone 10 [i.e., wireless communication unit] remotely located from the inherent hard-wired telephone (fig.2).

Claim 129 is rejected for the same reasons as discussed above with respect to claim 107. Furthermore, Norman teaches a reader that reads information from a PCMCIA [i.e., removable storage medium] (col.9, line 67-col.10, line 5, col.11, lines 8-14).

a controller [i.e., processor] (fig.1, item 50) for automatically setting the cellular telephone to receive one or more calls from a wireless service provider, the processor automatically setting the cellular telephone to receive the calls based on a changeable phone number corresponding to a user's mobile telephone number read by the reader from the removable storage medium (fig.2,5; col.5, lines 1-16, 66, 67, col.6, lines 1-19, col.9, line 56-col.10, line 9, col.11, lines 8-21, col.12, lines 12-32, 45-61, col.13, lines 19-23). (Note: permanent MIN number is stored in read only memory which is PCMCIA card (col.12, lines 55-60, col.13, lines 19-23))

Regarding claim 131, Norman teaches that the reader reads a user identification code from the removable storage medium and wherein the processor compares the user identification code to a re-stored code to authorize receiving calls based on the mobile telephone number of the user (col.9, line 67-col.10, line 5, col.11, lines 8-14, col.12, lines 12-32, 45-61, col.13, lines 19-23).

Regarding claim 132, Norman teaches that the information stored on the removable storage medium includes an ESN [i.e., serial number] used to authorize receipt of the calls (col.11, lines 8-14, 56-67, col.12, lines 12-32, 45-61, col.13, lines 19-23).

Regarding claim 134, Norman teaches that the information stored on the removable storage medium includes information which the wireless service provider or a local exchange carrier needs to activate operation of a wireless phone (fig.2; col.9, line 67-col.10, line 5, col.11, lines 8-14, col.12, lines 12-32, 45-61, col.13, lines 19-23).

Regarding claim 135, Norman teaches a communications port to receive telephone calls through a public switched telephone network (col.11, lines 22-27, col.12, lines 12-17).

Regarding claim 136, Norman teaches that the telephone calls received through the public switched telephone network bypass the wireless communications unit (col.12, lines 12-17).

Regarding claim 139, Norman teaches a connector to connect the wireless communications unit to a remotely located antenna (fig.2; col.12, lines 1-11).

Regarding claim 141, Norman teaches a keypad to enter a phone number to be dialed by the user based on the user's mobile telephone number to which the wireless communications unit is set by the processor (col.12, lines 51-61).

Regarding claim 144, Norman teaches after setting the wireless communications unit, the processor automatically transmits a signal to the wireless service provider to provide notification that the wireless communications unit is available to receive calls based on the user's mobile telephone number (col.11, lines 22-32, col.12, lines 12-31). (Note; when a wireless device is turned on it automatically signals the provider for its availability of receiving calls.)

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claim 133 is rejected under 35 U.S.C. 103(a) as being unpatentable over Norman et al. (U.S. Patent No. 5,485,505) in view of McDonnell et al. (U.S. Patent No. 6,771,972).

Claim 133 is rejected for the same reasons as discussed above with respect to claim 132. Furthermore, Norman does not specifically teach "the authorization information includes

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location information”. McDonnell teaches that the authorization information includes location information (col.6, lines 11-22). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Norman to incorporate the authorization information including location information as taught by McDonnell. The motivation for the modification is to have doing so in order to provide authorization for a particular location.

9. Claims 137 and 138 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norman et al. (U.S. Patent No. 5,485,505) in view of Bultman (U.S. Patent No. 6,804,536).

Regarding claim 137, Norman does not specifically teach “the processor generates a control signal to prevent reception of calls through the public switched telephone network when the wireless communications unit is activated”. Bultman teaches that the processor generates a control signal to prevent reception of calls through the public switched telephone network when the wireless communications unit is activated (abstract; col.1, lines 27-37). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Norman to incorporate the processor generating a control signal to prevent reception of calls through the public switched telephone network when the wireless communications unit is activated as taught by Bultman. The motivation for the modification is to have doing so in order to provide a choice to receive calls through a wireless communications unit.

Regarding claim 138, Norman does not specifically teach “the wireless communications unit is deactivated to allow calls to be received through the public switched telephone network when no removable storage medium is coupled to the reader”. Bultman teaches that the wireless communications unit is deactivated to allow calls to be received through the public switched

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telephone network when no removable storage medium is coupled to the reader (fig.11, item 1114). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Norman to incorporate the wireless communications unit is deactivated to allow calls to be received through the public switched telephone network when no removable storage medium is coupled to the reader as taught by Bultman. The motivation for the modification is to have doing so in order to provide a choice to receive calls through a wireline communications unit.

10. Claims 140 and 143 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norman et al. (U.S. Patent No. 5,485,505).

Regarding claims 140, 143, Norman does not specifically teach that the hard-wired telephone is located in a hotel room or in a kitchen appliance. Examiner takes official notice that the hard-wired telephone to be located in a hotel room or in a kitchen appliance are well known in the art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Norman to incorporate the hard-wired telephone' location in a hotel room or in a kitchen appliance in order to provide flexibility of using the telephone in different locations.

11. Claim 142 is rejected under 35 U.S.C. 103(a) as being unpatentable over Norman et al. (U.S. Patent No. 5,485,505) in view of Parrott et al. (U.S. Patent No. 6,618,580).

Regarding claim 142, Norman does not specifically teach "a USB port coupled to the removable storage medium for transferring said information to the reader". Parrott teaches a

USB port coupled to the removable storage medium for transferring said information to the reader (col.7, lines 32-35). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Norman to incorporate a USB port coupled to the removable storage medium for transferring the information to the reader as taught by Parrott. The motivation for the modification is to have doing so in order to attach the card with computer using a USB port.

12. Claim 145 is rejected under 35 U.S.C. 103(a) as being unpatentable over Norman et al. (U.S. Patent No. 5,485,505) in view of McGregor et al. (U.S. Patent No 5,577,100).

Regarding claim 145, Norman does not specifically teach “the processor places the wireless communications unit in call monitoring mode after receiving a confirmation signal from the wireless service provider, the confirmation signal received in response to the notification signal”. McGregor teaches this limitation (col.12, line 67, col.13, lines 1-4). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Norman to incorporate the processor placing the wireless communications unit in call monitoring mode after receiving a confirmation signal from the wireless service provider, the confirmation signal received in response to the notification signal as taught by McGregor. The motivation for the modification is to have doing so in order to bill the user at a later time.

13. Claims 146, 147, 151 and 152 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norman et al. (U.S. Patent No. 5,485,505) in view of Tayloe (U.S. Patent No 5,933,785).

Regarding claims 146 and 151, Norman does not specifically teach “the processor resets the wireless communications unit to receive calls based on a mobile telephone number of a new user, after the removable storage medium is replaced with a removable storage medium containing the new user's mobile telephone number”. Tayloe teaches this limitation (col.6, lines 39-57). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Norman to incorporate the processor resetting the wireless communications unit to receive calls based on a mobile telephone number of a new user, after the removable storage medium is replaced with a removable storage medium containing the new user's mobile telephone number as taught by Tayloe. The motivation for the modification is to have doing so in order to register new numbers from the new SIM card after removal of the old one.

Regarding claims 147 and 152, Norman does not specifically teach that the processor transmits a message to the wireless service provider to prevent the wireless communications unit from receiving calls from any number different from the new user's telephone number. Tayloe teaches this limitation (col.6, lines 39-57). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Norman to incorporate the processor transmitting a message to the wireless service provider to prevent the wireless communications unit from receiving calls from any number different from the new user's telephone number as taught by Tayloe. The motivation for the modification is to have doing so in order to un-register old numbers from the wireless unit.

14. Claims 148-150 and 153-155 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norman et al. (U.S. Patent No. 5,485,505) in view of Tsukamoto et al. (U.S. Patent No 5,128,981).

Regarding claims 148 and 153, Norman does not specifically teach “the processor automatically prevents the wireless communications unit from receiving calls corresponding to the user's mobile telephone number based on time-of-activation information entered by the user”. Tsukamoto teaches this limitation (col.4, lines 25-29, col.20, lines 58-68). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Norman to incorporate the processor automatically preventing the wireless communications unit from receiving calls corresponding to the user's mobile telephone number based on time-of-activation information entered by the user as taught by Tsukamoto. The motivation for the modification is to have doing so in order to restrict unwanted calls during a specific period of time.

Regarding claims 149 and 154, Norman does not specifically teach that the time-of-activation information indicates a period of time, and wherein the processor counts down the period of time while the wireless communications unit is set in a call monitoring mode to receive calls based on the user's mobile telephone number. Tsukamoto teaches this limitation (col.4, lines 25-29, col.20, lines 58-68, col.21, lines 4-8). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Norman to incorporate the time-of-activation information indicating a period of time, and wherein the processor counts down the period of time while the wireless communications unit is set in a call monitoring mode

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to receive calls based on the user's mobile telephone number as taught by Tsukamoto. The motivation for the modification is to have doing so in order to receive calls allowed for a particular time duration.

Regarding claims 150 and 155, Norman does not specifically teach that the time-of-activation information is set by the user through operation of the keypad. Tsukamoto teaches that the time-of-activation information is set by the user through operation of the execution key [i.e., keypad] (fig.7; col.12, lines 56-62, col.13, lines 3-31). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Norman to incorporate the time-of-activation information being set by the user through operation of the keypad in order to prepare different events for selected schedules.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

O'Neil et al. (U.S. 5,887,253) teach Method for activating and servicing a cellular telephone;

Shieh et al. (U.S. 6,591,098) teach System and method for using a temporary electronic serial number for over-the-air activation of a mobile device;

Zicker et al. (U.S. 5,878,339) teach Cellular radiotelephone system with remotely programmed mobile stations;

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Ghafoor (U.S. 6,618,587) teach Method and system for assigning multiple directory numbers (DN) to a personal communication system (PCS) telephone;

Williams (U.S. 5,774,804) teach Remote activation of mobile telephone by paging channel phantom numbers;

Delis et al. (U.S. 6,119,001) teach Roamer service auto-activation and deactivation in a home location register;

Henry, Jr. et al. (U.S. 5,603,084) teach Method and apparatus for remotely programming a cellular radiotelephone;

Zirul et al. (U.S. 6,912,399) teach Cellular telephone with programmable authorized telephone number and

Rosenthal et al. (U.S. 5,737,701) teach Automatic authentication system.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

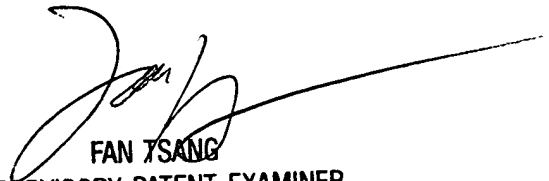
17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Md S. Elahee whose telephone number is (571) 272-7536. The examiner can normally be reached on Mon to Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ME

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